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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,864	05/09/2001	Natsume Matsuzaki	NAK1-BO73	4949
21611	7590	12/30/2005	EXAMINER	
SNELL & WILMER LLP 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			LIPMAN, JACOB	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,864

Applicant(s)

MATSUZAKI ET AL.

Examiner

Jacob Lipman

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 57-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 57-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claims 17 and 57-75 are objected to because of the following informalities:

The claims do not consistently use the same terms for the same items. For example, in claim 17 the portable key storage medium is referred to as just the key medium in line 12. Claim 62 also switches between calling it the portable key storage medium, and just the key medium. Claim 62 also switches between the terms the original key information, and the key information. While it is still possible to understand the claims with these informalities, it makes them more confusing, and appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17, 57-58, 60-65, 67-71, and 74 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schneier, in "Applied Cryptography second edition".

With regard to claim 62 and 17, Schneier discloses a file encryption apparatus (pages 180-182), that encrypts plaintext to generate a cipher text and stores the cipher text into a memory unit (page 180 last paragraph), including storing key information in a key storage medium (page 181 paragraph 2), registration means for receiving a password, which encrypts the key information and writes the encrypted key to memory (page 181 paragraphs 5-6), and an encryption unit which encrypts a plaintext using a file key (page 180 last paragraph), and encrypts the file key using the key information, before writing the encrypted file key to memory (page 181 paragraphs 5-6). Schneier further discloses switching between the key storage medium and password, to obtain the key information (page 182 paragraph 3-4, page 181 last paragraph), which obtains the key from both memory and the portable ROM key in order to decrypt the cipher text. If Schneier does not specifically teach all these limitations in one embodiment, and it is not inherent that they can be combined, it would at least have been obvious for one of ordinary skill in the art to use the backing up features with the storing keys feature to gain Schneier's given motivation of retaining keys upon accidental death.

With regard to claims 57, and 63 Schneier discloses the password is unique to Alice (page 180 last paragraph)

With regard to claims 58, 61, 64, and 65, if the encrypted key or cipher text has been altered, the key will not decrypt the cipher text.

With regard to claims 60 and 74, Schneier discloses the files are used together, and thus are associated to each other (page 181).

With regard to claims 67-71, Schneier discloses updating the key (page 180 section 8.6, pages 183-185).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 59, 66, 72, 73 and 75, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier.

With regard to claims 59 and 66, Schneier discloses the apparatus of claims 17 and 62, as outlined above, but does not specifically mention the storage medium being portable. The examiner takes official notice that portable computers are common, and well known in the art. It would have been obvious to one of ordinary skill in the art that Schneier's key storing techniques could be used in a portable device in order to secure the stored data. The examiner further points to *In re Lindberg*, 194 F.2d 732, 735, 93 USPQ 23, 26 (CCPA 1952) which states that making a device portable is an obvious modification to one of ordinary skill in the art.

With regard to claims 72, 73, and 75, Schneier discloses the apparatus of claim 69 as disclosed above, but does not specifically mention storing the files as a unified file. The examiner takes official notice that files are stored in directories, which are files containing multiple files. It would have been obvious to one of ordinary skill in the art to allow the user to place the key and cipher text in the same directory to be organized.

Response to Arguments

7. Applicant's arguments filed 14 October 2005 have been fully considered but they are not persuasive.

Applicant argues that Schneier does not disclose a switching apparatus. The examiner further points out that the claimed switching unit reads on backing up keys (Schneier 181-182). Schneier discloses that Alice normally uses her remembered key password (page 181 paragraph 6-9), but in case of emergency (she is hit by a truck), a key card can be used (page 181 last paragraph, page 182 paragraphs 3-4). Thus Schneier discloses a specific manner of operation wherein a key can be secured from one of two sources, as applicant asserts is the purpose of the switch.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Th 7 AM-3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL

David Y. Jung
Primary Examiner

12/23/06
